

Remarks

Filing Date Correction

Applicant notes that the filing date listed on the Office Action and also in PAIR, 05-02-2001, is incorrect. The filing date of the present application is 12-18-2000, as indicated by the petition granted on 07-18-01 by the Office, said petition being part of the official file and is reflected in PAIR. Applicant respectfully requests that the file wrapper and PAIR be updated to reflect the actual filing date of 12-18-2000. Applicant further notes that the present application claims the priority of U.S. Provisional Patent Application No. 60/172,397, filed on Dec. 17, 1999, and which has been incorporated by reference in its entirety in the present application.

Current Status

All claims stand rejected. Claims 52-54 stand rejected under 35 USC 101. Claims 4-51, 61 and 62 stand rejected under 35 USC 112 second paragraph. Claims 1-63 stand rejected under 35 USC 103(a). By this amendment, claims 2-3, 14, 18, 24, 28-29, 31-33, 35, 37-38, 42-43 46-48, 52 and 55-56 have been amended, and new dependent claims 64-84 have been added. Claims 6, 10-12, 15-16, 20-21, 23, 26, 30, 34, 36, 39-41, 44-45, 49, and 62-63 have been cancelled without prejudice. The number of claims, both independent and dependent does not exceed the number of claims as originally filed. The Examiner's rejection's are traversed below, and reconsideration is respectfully requested. With this amendment, including the remarks and discussion herein, Applicant believes the application is in condition for allowance

Rejections Under 35 101

Claims 52-54 have been rejected under 35 USC 101 as being directed to non-statutory subject matter in that they recite a system which comprises a human entity. The claims have been amended to exclude from their scope human beings, and thus the grounds for rejections have been overcome.

Rejections Under 35 USC 112 Second Paragraph

Claims 4-51, 61 and 62 have been rejected under 35 USC 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant respectfully traverses the rejections and submits that the claims are definite under 35 USC 112 and the Applicant has particularly pointed out and distinctly claimed Applicant's invention (discussed below). Reconsideration is respectfully requested. Applicant has amended many of the claims for the sake of clarity.

Examiner states that the although the dependent claims 4-6 further limit the assets, *"none of the process steps...depend or...are affected by what the asset includes (i.e., not functionally related to the process carried out in the method of claim 1). For example, method steps of identifying, assigning and recording are performed regardless of the specifics of the asset."* Respectfully, the Applicant disagrees and does not understand the reasoning of the Examiner as the utilization of dependent claims to claim specific embodiments and variations is a well known and accepted practice in claims drafting. The dependent claims under discussion (including those discussed below) further limit independent claim 1 by specifying, for example, a property, description, or nature of a class of assets. Of course the process steps listed in claim 1 are to be performed in the dependent claims as well; this is basic fact and essential ramification of the relationship between an independent claim and claims which depend therefrom. So for example, the method of claim 1 comprises process steps which are applied to assets in general, whereas for the dependent claims, one or more of those specific steps are applied to a specific class of assets only or a specific property of assets.

Furthermore, although the method steps of assigning, recording and categorizing the information, as well as managing read and write privileges and providing access to information to various entities does occur for each class of assets, the specifics of the information, and the specifics of how that information is assigned, categorized, recorded, and the specific entities and specific access rights provided can and will depend to varying extents on the type, class, or nature of the asset. This is clearly laid out and discussed in the specification (see for example FIGS 3-5 and 6-8 and the discussion thereof). Different classes of information and attributes are associated with different types of assets, and different classes of entities have varying degrees of interest in the asset or attributes thereof. For instance, with a multi-component or a multi-vendor asset (claims 4-8) may have

components from multiple vendors and may have varying interests from those multiple vendors, and thus the method steps of categorizing and recording information, and managing privileges and providing access will entail the categorization and recording of information and attributes unique to the asset class (e.g., each component part) and managing privileges and providing access to a unique 'class' of entities (e.g., each of the component producers or vendors). With respect to claims 2 and 3, the information being recorded, categorized and managed for only a portion of the life cycle of the asset (and those parties having interest in such information to which privileges are managed and access provide) can be distinct from (e.g., a subset of) that of an asset for which information is recorded for the entire life cycle of the asset.

With respect to claims 7-8, 9-21, 22-24, 25-27 Examiner takes the position that the recited asset or features "*have no relationship to*" or "*are not functionally related*" ... "*to the process steps of claim 1*". Applicant disagrees. As discussed above the distinct nature, class, or features of the asset can further limit the categorization and recording of information and attributes specific and unique to the class, property or feature of the asset as well as further limiting the specific entities and interests thereof and the distinct privileges and access granted to those specific entities. For instance, whether there is sole or joint ownership of an asset will affect how the ownership attribute is categorized and recorded and which entities (e.g., owner(s)) have which specific privileges and access. Additionally, whether the asset is a physical or intangible asset affect which and how the attributes will be recorded and categorized. For instance, the attribute of the weight of a precious metal asset is a critical attribute of the asset which would be recorded and stored, whereas the concept and value of weight would not be typically relevant or attributable to assets such as land or various forms of intellectual property such as patents and copyrights.

Further, whether and which documentation (e.g., manuals, warranties, service agreements) is recorded and categorized and which entities have an interest in the respective documentation may depend on the nature of the asset.

With respect to claims 28-44 and 47-49, Examiner asserts that the step of "storing data related to any change in status of the asset" "*does not functionally relate (or link) to any process recited in claim 1 since each process step can be performed regardless of whether the data related to any change in status of the asset is stored or not.*" Applicant disagrees. Claim 28 (and 29-44 and 47-49) further limits claim 1 by requiring that specific information related to a status change in the asset is recorded in the asset registry. Examples of such status changes, discussed in the specification and

detailed in subsequent claims include changes in ownership, value/appraisal, insurance, financing, repair history, added documentation, etc. Thus, any status change would potentially affect what and how the information related to that status change is recorded and categorized and which entities would be provided access (and level of access) as a result of that status change. The same is true for transactions affecting, causing or resulting from the status change. The specifics of such transactions, how they change the status (or any property) of the asset, and how those changes are to be recorded and/or how the various relevant entities grant or are granted privileges and access to the registry further limits the steps of claim 1

While the process steps of claim 1 don't require status changes to be recorded, the dependent claims under discussion specifically claim that such status changes will be recorded and thus are definite and particularly point out and distinctly claim Applicant's invention.

Regarding claims 45-46 and 50-51, Examiner states that the claims "*recite features of 'various entities' and 'read and write privileges' in a manner that does not functionally relate to the method steps of claim 1*". Applicant disagrees. As discussed above, each claim further limits the method of claim 1 by further specifying the nature of the asset, or entities, or how access rights are managed.

The discussions above pertain to claims 61 and 62 as well which are not indefinite under 35 USC 112.

The Applicant has shown that the claims, as presented in this amendment, in the light of the specification are not indefinite under 35 USC 112 second paragraph and that the Applicant has particularly pointed out and distinctly claimed the invention of the Applicant, and the rejections have been overcome. Withdrawal of the rejections is respectfully requested.

Rejections Under 35 USC 103

Claims 1-63 have been rejected under 35 USC 103(a) as obvious in view of Abraham et al. Applicant respectfully traverses the rejections. Reconsideration is respectfully requested in light of the remarks below.

Abraham discloses a method for controlling access to data elements in a data processing system based on the status of an industrial process by mapping user's security categories and industrial process steps. Abraham is concerned with methods for controlling data security in a data

processing system that controls an industrial process, the methods for controlling security involving assigning access rights or privileges to parties involved in the industrial production process at various points during the production process depending on the respective parties' relative involvement or required input in the production process. The primary need for such a system is to protect the security and prevent corruption of any of the vast number of data elements within the system. Because it may be the case that a great number of individuals within the organization are each involved in some way and at some point in the production process, it is important to restrict each person's access to only those data elements within the production system that each person is authorized to modify. The invention of Abraham provides a method for assigning specific access rights, to individuals (or groups of individual) involved in an industrial production process, to specific data elements (or categories of data elements) within a data processing system that controls the production process. The invention of Abraham is an improvement over various "engineering control management" and "revision control systems" that were well known at the time of the invention of Abraham. A primary purpose of each of these systems was to insure that the production process moved forward with consistency and accuracy by preventing the corruption of data, by maintaining access control, and restricting access to authorized parties.

Applicant respectfully points out that the invention disclosed by Abraham is very different from the present invention of the Applicant as claimed in claims 1, 52, and 55 and the claims dependent therefrom. Applicant's invention is concerned with, inter alia, methods, systems, and apparatus for the electronic registration of assets in general, examples of assets including real estate, automobiles, consumer good and electronic appliances, weapons, artwork, patents and copyrights, and generally anything that can be owned, and for which ownership rights can be transferred. The asset registry of the present invention provides for an electronic asset record for each registered asset, the asset record comprising pertinent information about the asset such as information pertaining to ownership, value, history of the asset, component makeup, warranty, insurance and legal information, current status, etc. Said asset record, maintained in an asset registry, being capable of being electronically accessed by various interested parties that may have an interest in the asset, such parties including the producer of the asset, the owner of the asset, a prospective buyer of the asset, and insurer or warrantor of the asset, a financier of the asset, a servicer of the asset a government or regulatory body concerned with the asset, etc. The asset registry allows for the maintenance of an up-to-date record of each relevant attribute of each assets and for access control to one or more of

those attributes by a parties of interest, and would provide for the capability for conducting transactions that alter the state of ownership and other attributes of the asset. Applicant's invention, moreover, provides significant and distinct advantages, as detailed in the specification and discussed further below, not taught or disclosed by the prior art.

The Examiner states that "*Abraham teaches a method for recording information related to assets throughout a cycle of the asset ...(independent projects, inherently each project is identified with a unique identifier)*". Examiner appears to have equated Abraham's concept of a project, in the context of the engineering control system, with that of Applicant asset concept. Applicant disagrees. The objective of Abraham's invention is to improve t control over of an industrial processes, whereas Applicant's invention is directed to the management of assets. What Applicant's means by "asset", as discussed above, and what Abraham means by "project" are very different. Respectfully, Examiner has improperly attempted to stretch the meaning of Abraham "project", which is limited to a compilation of data elements for a data processing system that controls an industrial process, to encompass Applicant's invention which is concerned with assets generally (e.g., assets which can be owned and for which ownership can be transferred). Examiner further attempts to stretch the meaning of Abraham by improperly equating the access control purpose of Abraham with that of the Applicant. The interested entities in Abraham are those concerned and affiliated with the creation and modification of data elements within a data processing project, i.e., the individuals or department that have various production roles in the development of the project. This is in contrast and significantly different than Applicant's invention where interested entities include those with an ownership, financial, or other interest in an asset and such interests extend beyond the mere production of the asset, e.g., the owner, insurer, financier of an automobile have interest that may extend through the life of the automobile. Abraham controls access to data in an industrial process. Applicant's invention provides a method and system for tracking an asset as it is created, and although Applicants invention could be applied in an industrial setting, the Applicant's invention also encompasses and accounts for all methods of creating numerous other classes of assets which are not part of an industrial process, assets such as intellectual property, artistic works, etc. Thus, as recited in independent claims 1, 52, and 55, an asset is something for which an element or legal ownership can be attributed and transferred, and interested entities are those parties, persons or organizations which have or may have an interest, e.g., duty, responsibility, benefit, obligation, stake etc., in the past, current and/or future status of the asset, such entities potentially being from different

organizations each having a different or varying interest in the asset. Abraham is concerned with data elements in an industrial control process and not to the ownership of the assets, as in the Applicant's invention. Further to the independent claims is that of providing various levels of read and write access to the asset registry and asset records and attributes of assets contained therein to these different entities depending on the entities interest or stake in the asset, e.g., degree of ownership or other financial interest of the asset, liability for asset, legal regulation of the asset, appraisal of the asset in anticipation of purchase or ownership change of the asset, etc. The Applicant's invention also allows for valuation of assets, which Abraham does not teach or suggest. For example, the value of any asset may be set by economic, market, or other forces, changes in which are a part of the asset record. None of these features is taught or suggested by the prior art and the claims are unobvious in view of the prior art.

Examiner cites *In re Oetiker* (Fed. Cir. 1992) to justify the application of Abraham in rejecting the claims of the present invention and states that "*the claimed invention pertains to controlling access (read and write privileges) to the information ... In this regard both the recited claims and the reference are concerned with solving a problem of providing access to the specific attributes (data elements of the information concerning a specific subject matter*"

Examiner then concludes "*It would have been obvious to apply the teaching of Abraham...to an asset registry in an analogous manner as the engineering control management...because that would have the benefits of controlling security of data elements in an environment where a plurality of entities (user groups in Abraham) have access to the information pertaining to the asset registry*".

Applicant respectfully disagrees and submits that Applicant's invention is not obvious in view of Abraham. Although the invention of the Applicant comprises elements of granting and controlling access and read/write privileges to various interested entities, this is neither the sole primary feature of the invention (as it is in Abraham), nor is such granting and controlling access in the same context as that of Abraham. Abraham is concerned with security and access control of a particular data processing system within a particular organization and for a specific production process whereas Applicant's invention is concerned with the registration of assets generally, within and without specific organizations and including the lifecycle subsequent to production. Moreover, the asset concept, as in the present invention is absent from that of Abraham. Applicant's invention addresses, inter alia, the registration of any and all classes of assets by the creation of an asset record

and provides for the capability of all interested parties to have specific access rights to the asset record and to access, update or otherwise modify authorized information over the Internet or other electronic network. This is very different as contrasted with the invention with Abraham which is concerned only with controlling access rights to data elements of a specific data processing system directed toward the control of a single industrial process within a single organization. Thus, while Abraham is concerned primarily with the problem of controlling access to data elements of a project within an organization, Applicant's invention is directed to the registration of assets generally and the manipulation of the registered assets' records. Furthermore, Abraham does not speak to ownership of the asset, which is a feature of the Applicant's invention.

Examiner appears to be improperly presuming that Applicant's innovative technique of registering assets and providing levels of access to interested parties is already known and the use of access control such as in Abraham is thus an obvious modification, which is not the case. Moreover, the motivation given by Examiner in applying Abraham, "to improve security", is too general because it could cover almost any invention, that had as one of its components or steps, a form of access control similar to what is disclosed in Abraham; additionally, there is nothing in the referenced art that would suggest asset registration in general as in the Applicant's invention.

Applicant respectfully submits that the Examiner reasoning is improper and relies on hindsight. As stated by the Federal Circuit:

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness ...By defining the inventors problem in terms of the its solution, the district court missed the necessary antecedent question, namely, whether the prior art contains suggestion or motivation...Monarch Knitting Mach Corp v Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ 2d 1977

Further, it appears that the Examiner is suggesting that the present invention is rendered obvious because a component of the invention, that is the security and access control utilized by the invention, has analogous properties to engineering control management principles, even though the application is clearly different than that of engineering control management and provides numerous features and benefits which have nothing in common with the referenced prior art.

As stated by the Federal Circuit, In re Fritch , 972 F.2d, 1260, 23 USPQ 2d 1780, 1784 (1992)

“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.... One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed inventions”

Examiner further states, *“It is also asserted that the reference method of controlling access to data elements in a data processing system may be adapted for other applications including information management of asset registries ... the motivation of such adaptation is discussed in claim 1 ”.*

Notwithstanding the Examiner’s assertion, this is neither a test for obviousness nor does it render the claimed invention obvious. Obviousness cannot be predicated on whether one of ordinary skill in the art would have the capabilities to arrive at the invention. In Ex parte Levengood, 28 USPQ 2d 1300 (Bd. Pat App. & Inter 1993), the Board stated:

At best, the Examiner’s comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the appellants inventions because he had the necessary skills to carry out the request process. This is an inappropriate standard for obviousness.. That which is within the capabilities of one skilled in the art is not synonymous with obviousness

With regard to the claims limitation “for the entire lifecycle of the asset”, Examiner refers to Abraham stating *“the asset (project) ...progresses through a series of step, etc. which implies life cycle of a project”*. Applicant respectfully points out that Examiner has misconstrued the Applicant’s concept of lifecycle vis-à-vis that of Abraham. In Abraham, each project may have a development cycle in which data elements are modified until the project is completed, but this is completely different than that asset lifecycle of the Applicant’s invention, which includes information, status changes, and interested entities of the asset before, during, and after production, sale, etc. of the asset. Furthermore, the created asset record can become part of the asset itself and can be transferred with

the asset (e.g., sold with the asset) as distinct from Abraham where the project record remains within the organization.

Regarding claims 52-54, although Abraham discloses that users affiliated with the project may be distributed and thus connected by some sort of network, this fact is not relevant because, as has been discussed, Applicant's invention is very different from that of Abraham, and directed to the registration of assets generally, with numerous advantages not found in Abraham or in the prior art. The fact that Abraham's "user" may utilize a network to access a project ongoing within the user organization makes Abraham no more relevant than systems which utilize a network with which to transfer data between distributed computers.

With regard to claim 54, Examiner take Official Notice that "providing information concerning asset management over the Internet is old and well known in the art" and that "*it would have been obvious ... to incorporate the system of Abraham such that users may access the asset registry over the Internet*". Applicant respectfully challenges Examiner's assertion above regarding providing information concerning asset management over the Internet, and requests that Examiner substantiate his assertion by providing evidence, e.g., by citing specific prior art. Applicant concedes that transmitting information over the Internet is old and well known, but submits that providing information concerning asset management, as contemplated by the present invention, was not known or taught by the prior art at the time of Applicant's invention, nor was there as suggestion to do so.

The rejections of system claims 55-61 are traversed and should be withdrawn. The discussions above are applied and directly relevant to claims 55-61, which are not obvious in view of the prior art for the points and reasons already discussed.

With regard to newly added claims 64-84, each of these claims depends from, directly or indirectly from either independent claims 1 or 52, and contain all the limitations of their respective parent claim. Claims 1 and 52 have been shown to unobvious and patentable in view of the prior art and therefore claims 64-84 are also unobvious and patentable in view of the prior art because they further limit the independent claim from which they depend. For example, claims 64 and 79 specify that at least two of the entities are from different organizations; claims 65 and 81 further define an asset as something for which legal ownership can be transferred; claims 68, 70, 78, 81, and 83 further specify the types of entities; claims 69 and 82 further specify the type of asset and such These additional features as discussed are not taught or suggested by the prior art. Claims 71-75 and 84 are

drawn to an asset record created by the method and system of claims 1 and 52 respectively. Such an asset record is not disclosed or taught by the prior art as has already been discussed.

Applicant's invention provides numerous advantages not disclosed, taught, or contemplated by the prior art. Applicant's invention provides methods and systems whereby many different organizations having varying interests in the same asset can share or access information concerning that asset, and by which transactions and status changes concerning assets can easily be recorded and appropriate interested parties notified electronically, thus greatly increasing efficiency and accurateness, while potentially reducing costs. For example, Applicant's invention provides an efficient method for asset information management such that asset data and records are maintained and are not "lost", e.g., after a transfer of ownership, and such that the "history" of the asset can be chronicled and maintained in a single comprehensive record. The asset registry and asset records provide a single and comprehensive source for attributing ownership of an asset or property to as well as maintaining an up-to-date status regarding relevant attributes providing for all types of interested parties to participate in the registry, including owners, producers, sellers, financiers, insurers, law enforcement agencies, courts of law, legislative and regulatory agencies bodies. The system greatly enhances accuracy, efficiency and ease of use, by linking all the asset pertinent information together in a single record, obviating the need to refer to multiple unconnected and disparate records. The asset registry provides a great benefit to asset owners who would have an accurate and complete historical record of their assets including an audit-able trail of asset transactions and status changes, as well as the ability to share such information with whomever they chose, e.g., including prospective purchasers, insurers, law enforcement, etc. Furthermore, the invention provides a single strategy that allows for the record of ownership and history of assets to be developed, transferred and accessible in a standardized format using a standardized approach which would greatly facilitate the integration of disparate and unconnected records across multiple data sources. These and other benefits of a asset registry comprising accurate and comprehensive asset records that are readily electronically accessible via a network by multiple parties and to which varying degrees of access can be granted are not taught or suggested by the prior art.

Respectfully, all rejections have been overcome and should be withdrawn.

Conclusion

For all the reasons discussed above, Applicant believes that all rejections have been overcome and submits that the application is in condition for allowance and requests a timely Notice of Allowance be issued.

Respectfully submitted,

/Gregory Flickinger, Reg. No. 45,271/
Gregory Flickinger
Telephone: 706-291-6071

Frederik M. DeWolf
/Frederik M. DeWolf/

Steven Lutter
/Steven Lutter/